

Serial No. 09/468,173
Page 15

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed March 15, 2004. In the Action, the Examiner notes that claims 1-2 are pending, of which claims 1-2 stand rejected. By this amendment, claims 1 and 2 have been amended, and new claims 3-18 have been added.

In view of both the amendments presented above and the following discussion, the applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, the applicants believe that all of these claims are now in allowable form.

It is to be understood that the applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to applicants' subject matter recited in the pending claims. Further, applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant responsive amendments.

The above amendments are not made for patentability reasons. As such, the above amendments do not invoke the restrictions on the Doctrine of Equivalents as required under Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558 (Fed. Cir. 2000) (en banc). Consequently, the applicants should be accorded the full scope of the claims under the Doctrine of Equivalents.

In the Specification:

The Applicants have amended the specification to provide minor grammatical corrections and change reference designations to conform to the reference designations in the drawings. The Applicants submit that such grammatical corrections or reference designation changes do not add any new subject matter to the application.

Further, the Applicants have amended the specification to update serial numbers to corresponding patent numbers for patent references incorporated by reference therein. The Applicants submit that such changes to the incorporated reference designations do not add any new subject matter to the application.

277910-1

Serial No. 09/468,173
Page 16

REJECTION OF CLAIMS UNDER 35 U.S.C. §103(a)

Claims 1-2

The Examiner has rejected claims 1-2 under 35 U.S.C. §103(a) as being unpatentable over Coleman et al. (U.S. Patent No. 5,844,620, hereinafter "Coleman") in view of Obikane (U.S. Patent No. 6,404,818, hereinafter "Obikane"). The rejection is respectfully traversed.

The Applicants have amended independent method claim 2 to an apparatus claim that depends from independent claims 1. Therefore the rejection with respect to previous method claim 2 is now considered as being moot. Further, the Applicants have amended independent apparatus claim 1 to further clarify the features that the Applicants consider as being inventive. Support for the amendments to claims 1 and 2, as well as support for new claims 3-18, may be found in Applicants' specification at pages 55-60 and FIGS. 40-44C. In particular, Applicants' claim 1, as amended, recites:

"An apparatus for forming a multiplexed transport stream to deliver an interactive program guide (IPG), the apparatus comprising:
an encoder and packetizer adapted (i) to receive a plurality of video inputs, an audio input, and a plurality of data inputs, and (ii) to encode and packetize the inputs to generate a plurality of video packet streams, an audio packet stream, and a plurality of data packet streams;
a multiplexer and assigner adapted (i) to receive the plurality of video packet streams, the audio packet stream, and the plurality of data packet streams, (ii) to assign program identifiers (PIDs) to said packet streams, and (iii) to multiplex said packet streams to form the transport stream; and
a program mapping table for storing (i) PID assignment of video, audio, and data PIDs associated with a timeslot having a viewership level greater than a predetermined threshold, (ii) PID assignment of video and audio programming associated with a predetermined time period, and (iii) PID assignment of data PIDs associated with said video and audio programming associated with said predetermined time period." (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather, the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The combination of Coleman and Obikane fails to teach or suggest the applicants' invention as a whole.

277910-1

Serial No. 09/468,173
Page 17

Coleman discloses an interactive on-screen interface guide for selecting video programming. In particular, an IPG data processor outputs both a high-speed demand data stream 17 and a low-rate trickle data stream 19. The trickle data stream provides programming information for a current time period, e.g., the next forty-eight hours, and is stored in a local memory for immediate access. A demand data stream provides programming information for a future time period, e.g., one week beyond the current period, and is acquired on a real time basis in response to a subscriber's request for future scheduling information (see Coleman, Abstract, FIG. 1, and col. 6, lines 30-45).

However, the Coleman reference fails to disclose "an encoder and packetizer adapted (ii) to encode and packetize the inputs to generate a plurality of video packet streams," and "a multiplexer and assigner adapted (i) to receive the plurality of video packet streams, the audio packet stream, and the plurality of data packet streams, (ii) to assign program identifiers (PIDs) to said packet streams." Moreover, the Coleman reference fails to disclose "a program mapping table for storing (i) PID assignment of video, audio, and data PIDs associated with a timeslot having a viewership level greater than a predetermined threshold, (ii) PID assignment of video and audio programming associated with a predetermined time period, and (iii) PID assignment of data PIDs associated with said video and audio programming associated with said predetermined time period."

Furthermore, the Obikane reference fails to bridge the substantial gap as between the Coleman reference and the Applicants' invention. In particular, Obikane discloses that program information to be transmitted is formed hierarchically, and consists of a higher hierarchy program association table (PAT), and a lower hierarchy program map table (PMT). The higher hierarchy program information PAT is the information to show the packet identification information PID of TS packet in which the program information PMT formed per program is stored, that is, the information like a table of contents on the PMT. The lower hierarchy PMT is the information to show the packet identification information PID of TS packet in which each data forming the program is stored, per program and is the detailed program information formed per program. Accordingly, by referring to the program information PMT, it is possible to know in which TS packet each data forming the program is stored (see Obikane, col. 3, lines 27-65, and col. 10, lines 50-57).

277910-1

Serial No. 09/468,173
Page 18

Even if the two references could somehow be operably combined, the combination would merely disclose a first stream providing programming information for a current time period, a second stream providing programming information for a future time period, and a PMT that includes information to show the packet identification information PID of a TS packet in which each data forming the program is stored, per program, and is the detailed program information formed per program.

By contrast, the Applicants' invention solves a problem of providing IPG information to subscribers based on their viewing habits, as well as providing future scheduling information. The Applicants solve this problem in part by utilizing "a program mapping table (PMT) for storing (i) PID assignment of video, audio, and data PIDs associated with a timeslot having a viewership level greater than a predetermined threshold, (ii) PID assignment of video and audio programming associated with a predetermined time period, and (iii) PID assignment of data PIDs associated with said video and audio programming associated with said predetermined time period." The combined references fail to embrace the problems that the applicants' invention solves. Therefore, the combination of Coleman and Obikane fails to teach or suggest the Applicants' invention as a whole.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, new independent claim 10 recites similar features as discussed with regard to independent claim 1. As such, the Applicants submit that independent claim 10 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder.

Furthermore, claims 2-9 and 11-18 respectively depend, either directly or indirectly, from independent claims 1 and 10, and recite additional features thereof. As such and for at least the same reasons as discussed above with respect to claims 1 and 10, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

277910-1

Serial No. 09/468,173
Page 19

CONCLUSION

The applicants submit that claims 1-2 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

6/15/2004

E J Wall

Eamon J. Wall, Attorney
Reg. No. 39,414
(732) 530-9404

Moser, Patterson & Sheridan, LLP
Attorneys at Law
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702

277910-1